

Appl. No. 09/438,856
Amdt. Dated 03/01/2006
Reply to Office Action of 09/01/2005

REMARKS

This is in response to the Office Action mailed on September 1, 2005. In the Office Action, (i) claims 6, 8-9, 15, 17-18, and 38-39 were objected for being dependent claims; (ii) claims 1-3, 10-12, 19-36, and 40-48 were rejected under 35 U.S.C. 103(a); and (iii) claims 7, 16, and 37 were indicated as being allowed.

Reexamination and reconsideration of this case is respectfully requested in view of the foregoing amendments and the following remarks.

Claims 1-3, 6-12, and 15-48 were previously pending. Claims 4-5 and 13-14 were previously cancelled without prejudice. No claim has been cancelled or added by this response. Claims 1, 6, and 15 have been amended. Accordingly, claims 1-3, 6-12, and 15-48 remain at issue. Of those at issue, claims 1, 6, 7, 10, 15, 16, 31, and 37 are independent claims.

Applicant believes that no new matter has been added by this response.

I. Allowed Claims

In section 6, the Office Action indicated that claims 7, 16, and 37 are allowed.

Applicant respectfully thanks the Examiner for such indication.

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II. Information Disclosure Statement

Applicant filed an information disclosure statement (IDS) coincidentally with the filing of an RCE on 08/18/2004. Applicant has searched private PAIR and found that a copy of the IDS was indeed received by the USPTO. A copy of the 08/18/2004 IDS without the references is attached hereto as Appendix I.

Applicant did not receive a checked and signed Form 1449 with the Office Action mailed on 11/18/2004 or the Office Action mailed on 09/01/2005 indicating that the IDS filed on 08/18/2004 was considered.

For its records, Applicant respectfully requests a copy of the checked and signed Form 1449 for the IDS filed on 08/18/2004 with any further action mailed from the USPTO to be sure it has been considered.

III. Claim Objections

In sections 6.1 and 6.2, the Office Action objected to claims 6, 8-9, 15, 17-18, and 38-39 for being dependent on rejected base claims. The Office Action indicated that these claims would be allowable if rewritten into independent form including all the limitations of the independent claims and the intervening claims.

Applicant has amended claims 6 and 15 into independent form by including the limitations of independent claim 1 and 10 from which they previously depended. Claim 8-9 depend from independent claim 6. Claims 17-18 depend from independent claim 15. Applicant believes that these amendments to claims 6 and 15 now make this objection moot as to claims 6, 8-9, 15, and 17-18.

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Claims 38-39 remain dependent upon independent claim 31. From the remarks that follow below, Applicant respectfully believes that claim 31 is in condition for allowance such that claims 38-39 depending there-from with additional limitations are also in condition for allowance.

According, Applicant respectfully request the withdrawal of the objection to these claims.

IV. Claim Rejections 35 U.S.C. 103

In section 5 of the Office Action, claims 1-3, 10-12, 19-36, and 40-48 were rejected under 35 U.S.C. 103(a) over U.S. Patent No. 5,446,676 issued to Huang et al. ("Huang") in view of U.S. Patent No. 5,278,769 issued to Bair et al. ("Bair").

Applicant respectfully traverses the 35 USC 103(a) claim rejections.

"To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)" [MPEP § 2142; 8th Edition, Rev. 3, August 2005, Pg. 2100-134].

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The Office Action alleges that Huang discloses:

"adding a first simulation routine to said SPICE netlist to perform a reference simulation of said SPICE netlist to arrive at nominal values for selected vector measurements (Figure 1 items 12, 14, 16 and 18 and Col. 4 line 47 "AS shown in FIG. 1, circuits formatted in a foreign netlist format 10 such as the SPICE (S-P-I-C-E) format should be translated into a native format for simulator 22. Spice2t." and then Col. 4 line 61, "Aliasfile 16 contains aliases for specified nodes in the SPICE netlist. During translation, names in the SPICE netlist referenced in the aliasfile 16 are converted to the alternate name specified in the aliasfile." And Figure 8 items 202, 204, 206, 208),"

"adding a perturbing routine to said SPICE netlist for altering circuit parameter values of said circuit design in a pre-determined manner; (Figure 8 item 212, Figure 1 item 34, Figure 9 item 133 "TRANSISTOR PARAMETER RECORD n" and Col. 5 line 2 "Stimulus file 34 contains input data used to stimulate the simulated circuit in simulator 22. The data or stimuli contained in file 34 may be in a variety of formats, including conventional test vectors, simulated clock input, constant period w r stimulus specification (stimulus signals to be applied at fixed time intervals) and logical one and zero constants."),"

"adding a second simulation routine to said SPICE netlist for performing simulations of said circuit design for respective altered circuit parameter values to arrive at respective selected vector measurements; and (Figure 1 item 26, 30 and 22 and Table 1, and Col. 9 line 10; "At Vs=O(zero), Vt=VTO, which

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is a SPICE parameter defined for any transistor model. This value may be adjusted by control file 24 parameter thresholdmos (item 9 of Table 1.)"),"

and

"adding an analysis routine to said SPICE netlist for manipulating at least one of said selected vector measurements in accordance with said predetermined analysis (Figure 1 item 34 and Col. 13 line 50 "In addition to test vectors, this file contains initialization vectors to set the simulated circuit to a predefined state prior to beginning actual simulation")"

Applicant respectfully disagrees.

The cited sections in Huang for allegedly disclosing "adding a first simulation routine to said SPICE netlist to perform a reference simulation of said SPICE netlist to arrive at nominal values for selected vector measurements" describe nothing more than a netlist conversion. Huang doesn't disclose here "perform[ing] a reference simulation of said SPICE netlist to arrive at nominal values for selected vector measurements" as is recited in the claims.

Moreover as discussed in Applicant's specification, "the user sets the desired vector measurements for the simulation template analysis. This can be, for example, a voltage at a particular node, current along a particular branch, and/or the power dissipation across a particular component." [Specification, page 6, line 31 to page 7, line 2].

The cited sections in Huang for allegedly disclosing "adding a perturbing routine to said SPICE netlist for altering

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circuit parameter values of said circuit design in a pre-determined manner" are nothing more than the description of an input data file or stimulus file. It does not disclose "altering **circuit parameter values** of said circuit design" as is recited in the claim. (emphasis added).

For example, Huang doesn't disclose modifying a netlist "to include tolerance information" for resistance or capacitance of respective resistors or capacitors as is disclosed in Applicant's specification. [Specification, page 11, lines 6-9]. Huang doesn't disclose adding "routines for varying the parameter values within the tolerance limits" as disclosed in Applicant's specification. [Specification, page 7, line 24].

The cited sections in Huang for allegedly disclosing "adding a second simulation routine to said SPICE netlist for performing simulations of said circuit design for respective altered circuit parameter values to arrive at respective selected vector measurements" describe computing the "threshold voltage of a transistor as a function of the body bias voltage". [Huang, Col. 9, lines 4-5, and Huang's equation (7)]. This does not disclose "adding a second simulation routine to said SPICE netlist for performing simulations of said circuit design for respective altered circuit parameter values to arrive at respective selected vector measurements" as is recited in the claims.

The cited sections in Huang for allegedly disclosing "adding an analysis routine to said SPICE netlist for

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manipulating at least one of said selected vector measurements in accordance with said predetermined analysis" only describe setting "the simulated circuit to a predefined state prior to beginning actual simulation" through the use of initialization vectors for an event-driven simulation. [Huang Col. 13, lines 51-52]. Huang does not describe any sort of analysis here of any selected vector measurement.

The Office Action admits that the Huang "reference does not expressly disclose the use of simulation Templates." Instead the Office Action alleges that the Bair "reference discloses the use of simulation templates (Figure 10 and Col. 7 lines 44-46)."

Applicant respectfully disagrees.

As is more fully discussed in Bair's detailed description, Bair's "FIG. 10 is a listing of a logic simulator model source file (i.e., 230 with respect to FIG. 2) listing the appropriate delays, primitives, and timing relationships between pins. These results were derived from the auto-model generator (i.e., 226 with respect to FIG. 2)." This corresponds to Bair's circuit schematic of BSCN2_VRL illustrated in Bair's Figure 11. Bair only describes this as a template because the "layout-related parameters (capacitances) have not been supplied". [Bair, Col. 7, lines 45-46].

Thus for at least the forgoing reasons, the combination of Huang and Bair do not make Applicant's rejected independent claims 1, 10, and 31 obvious.

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Regarding dependent claims 3 and 12, section 5.10 of the Office Action used the legal precedent of "eliminating element" discussed in MPEP §2144.04(II)(A) to reject dependent claims 3 and 12.

If the facts in a prior legal decision are not similar to those in an application under examination, the examiner may not use the rationale used by the court. [MPEP § 2144.04, 8th Edition, Rev. 3, August 2005; page 2100-144].

The cited legal precedent for omission of an element and its function in MPEP §2144.04(II)(A.) is *Ex parte Wu*, 10 USPQ 2031 (Bd. Pat. App. & Inter. 1989). Applicant previously provided a copy of the decision in *Ex Parte Wu*.

The claims and application in *Ex parte Wu* were "directed to a process for using a particular composition to inhibit corrosion on a metal surface." [*Ex parte Wu*, 10 USPQ 2031 at 2032 (Bd. Pat. App. & Inter. 1989)]. **Patentability in *Ex parte Wu* turned on the material composition and the claim language "consisting of" that excluded other elements from being a part of the claimed material composition. (emphasis added) The material composition of the prior art reference in *Ex parte Wu* disclosed all of the elements of the claimed material composition but with additional elements. (emphasis added) The court found that omitting the additional elements in the material composition of the prior art reference was obvious. (emphasis added)**

The *Ex parte Wu* claims were directed to material compositions by reciting a "method of decreasing corrosion rate by contacting a metal surface with a material composition

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consisting of" in the chemical or material science arts. Ex parte Wu claims did not involve claims directed to a computer readable medium or a method of modifying a SPICE netlist for a software simulator in the general field of computer programming.

Moreover, **Applicant's claims 3 and 12 do not recite the limitation "consisting of" in order to exclude other elements from a set of elements. (emphasis added) Applicant's claims 3 and 12 recite an additional step of "removing parameter and vector save statements in said SPICE netlist". (emphasis added) [Claims 3, 12 as amended, lines 2-3]. This conserves "memory space since a vector measurement may comprise large amounts of data, which would require a substantial memory size if numerous simulations are performed in the simulation template analysis." [Specification, page 8, lines 7-9].**

Additionally, **the Office Action does not properly apply the legal precedent to exclude an element found in the prior art reference of Bair. (emphasis added) In Ex Parte Wu, an element found in the material composition of the prior art reference was excluded in order to make the claims obvious. (emphasis added) A prior Office Action admitted that Bair "does not expressly disclose the additional limitation." [Final Office Action, page 9, section 66, line 1]. As Bair does not disclose an additional limitation that is supposed to be excluded by Applicant's claims, there is no reason to apply the legal precedent set forth by Ex Parte Wu. (emphasis added).**

The Office Action has failed to find Applicant's additional limitation in a prior art reference.

This Office Action states that "there are no unexpected results from this admission so that MPEP 2144.04(II)(B) does not apply." Applicant has not argued that there was an unexpected

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result. Applicant has consistently argued that the facts surrounding the legal precedent are not similar to those in this case.

Applicant respectfully submits that the facts of *Ex parte Wu* are not sufficiently similar to the facts in Applicant's patent application and Applicant's claims.

For the foregoing reasons, Applicant respectfully submits that the Examiner cannot rely on the legal precedent (eliminating element) of *Ex parte Wu* to reject Applicant's claims 3 and 12.

Moreover, rejected dependent claims 2-3, 19-24, 40-42 depend directly or indirectly from independent claim 1. Rejected dependent claims 11-12, 25-30, 43-45 depend directly or indirectly from independent claim 10. Rejected dependent claims 32-36, 46-48 and objected dependent claims 38-39 depend directly or indirectly from independent claim 31.

Applicant believes that it has placed independent claims 1, 10, and 31 in condition for allowance such that dependent claims depending there-from with added limitations are also in condition for allowance.

Accordingly, Applicant respectfully requests the withdrawal of the 35 USC § 103(a) claim rejections of claims 1-3, 10-12, 19-36, and 40-48.

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CONCLUSION

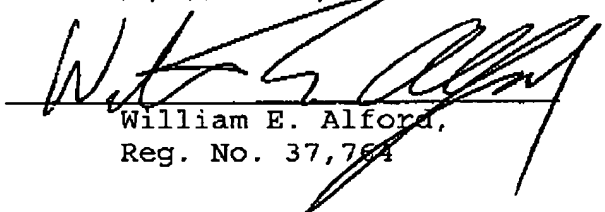
In view of the foregoing it is respectfully submitted that the pending claims are in condition for allowance. Reconsideration is requested. Allowance of the claims at an early date is solicited.

The Examiner is invited to contact Applicant's undersigned counsel by telephone at (714) 557-3800 to expedite the prosecution of this case should there be any unresolved matters remaining. Please charge any shortage in fees in connection with the filing of this paper to Deposit Account 02-2666 and please credit any excess fees to such deposit account.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: March 1, 2006


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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being transmitted via facsimile to the Patent and Trademark Office under 37 CFR §1.8 on: March 1, 2006 to Examiner Dwin M. Craig at (571) 273-8300.


Colette Angle

3/1/2006
Date

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Appendix I

Information Disclosure Statement
08/18/2004

Attny No. 003104.P002

Docket No.: 3104P002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of:

LAWRENCE G. MEARES

Application No.: 09/438,856

Filed: November 12, 1999

For: **SYSTEM AND METHOD OF
PROVIDING ADDITIONAL CIRCUIT
ANALYSIS USING SIMULATION
TEMPLATES**



Art Group: 2123

Examiner: Eduardo Garcia-Otero

INFORMATION DISCLOSURE STATEMENT UNDER 37 C.F.R. §1.97

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the duty of disclosure, enclosed is a copy of Information Disclosure Statement by Applicant (form PTO/SB/08), which is being submitted concurrently with the Request for Continued Examination. It is respectfully requested that the cited references be considered and that the enclosed copy of PTO/SB/08 be initialed by the Examiner to indicate such consideration and a copy thereof returned to applicant(s).

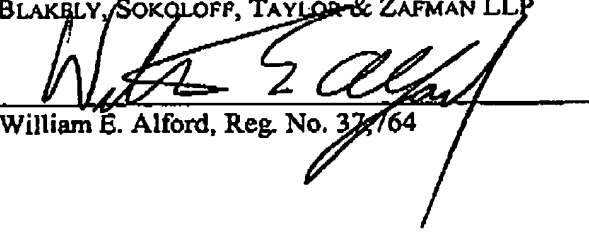
The submission of this Information Disclosure Statement is not to be construed as a representation that a search has been made in the subject application and is not to be construed as an admission that the information cited in this statement is material to patentability.

Please charge any fees due to Deposit Account 02-2666. A duplicate copy of the Fee Transmittal (PTO/SB/17) is enclosed for this purpose.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Date: August 18, 2004


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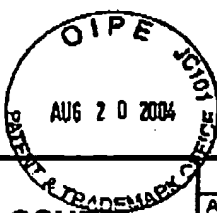
I hereby certify that this correspondence is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



08-18-04

Pat Sullivan

Date



Substituted for form 1449A/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT				Complete if Known	
				Application Number	09/438,856
				Filing Date	November 12, 1999
				First Named Inventor	Lawrence G. Mearns
				Art Unit	2123
				Examiner Name	Eduardo Garcia-Otero
				Attorney Docket Number	3104P002
Sheet	1	of	1		

[illegible]

Examiner Signature	Date Considered
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*Examiner: Initial R reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication.

*Applicant's unique citation designation number. *Applicant is to place a check mark here if English language Translation is attached.

Based on PTO/USB 05B (08-03) as modified by Blakely, Sokoloff, Taylor & Zelman (w/0) 08/11/2003.
Send To: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450